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10/583,866	06/21/2006	Makoto Kihara	292788US0PCT	8690
22850 7590 12/30/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER GWARTNEY, ELIZABETH A				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
12/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/583,866

Applicant(s)

KIHARA ET AL.

Examiner

Elizabeth Gwartney

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date 20090922

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment filed 22 September 2009 has been entered. Claims 3 and 8-16 have been cancelled and claims 17-29 have been added. Claims 1-7 and 17-29 are pending.
2. The previous specification objection, claim objections and 112 2nd Paragraph rejections with regards to claim 16 have been withdrawn in light of applicant's amendments made 22 September 2009.
3. Newly submitted claims 28-29 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The currently-presented claims are not readable on the elected invention because claims 28 and 29 are drawn to a method of making a food, food product or flour-containing food product wherein the invention as examined was drawn to a food or food product.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-29 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

4. Claim 28 is objected to because of the following informalities: Applicants use the term "product" in line 5 which appears to be a typographical error and should read "produce." Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 and 17-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 17, there is not support in the specification or claims as originally filed for soaking the seeds *without germinating* the seed. While the specification discloses breads manufactured with barley processed product only processed in the soaking process (p.20/L15-16) and barley processed product only with the soaking process (p.21/L15-16), the specification does not disclose soaking the seeds *without germinating*. The disclosure of a process wherein the product is *only* soaked does not exclude germination since germination would occur in a soaking process. Further, negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

Claims 1 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a food product or flour-containing food product containing processed barley, does not reasonably provide enablement for a food product

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or flour-containing food product containing wheat, oats or rye. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicants broadly claim "soaking the seeds of at least one of wheat, barley, oats or rye in water or hot water" and controlling the temperature, time period, or temperature and time period of at least one step of a kneading process, a fermentation process, or an aging process." Here, the disclosure provides no guidance as to the soaking parameters including time and temperature. Further, the while the disclosure provides guidance for kneading and fermenting a bread product comprising a processed barley ingredient wherein the barley ingredient is processed by soaking the barley in water or hot water, there is not enough guidance to practice the invention with the breadth presently claimed. For example, it is not clear what time and temperature is required for soaking the grain and what kneading, fermentation or aging parameters are required for a given soaking regime.

The practice of the presently claimed invention would require undue experimentation by one of ordinary skill in the art.

8. Claims 1-7 and 17-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the recitation "controlling the temperature, time period or temperature and time period" renders the claim indefinite because it is not clear as to what parameters the temperature and time period are being controlled within. Without

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further guidance, one of ordinary skill in the art would not be able to determine the metes and bounds of the claim.

The term "hot" in claims 1 and 28 is a relative term which renders the claims indefinite. The term "hot" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Regarding claims 1, 5-6 and 7, the phrases "increasing the content of" or "having an increased amount" of at least one free amino acid, GABA or dietary fiber, render the claims indefinite because it is not clear how the increase is being compared. In other words, it is not clear if the increase in content is relative to a product without the ingredient or an ingredient that has not been processed as presently claimed.

Regarding claim 19, the limitation wherein the added ingredient is barley *malt* or barley *malt* flour renders the claim indefinite because it is not clear how the ingredient can be processed without germination but still be labeled *malt*.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2, 4-7 and 17-18, 20, 22-26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamazaki et al. (US 6,106,887).

Regarding claims 1-2, 4-7, 17-18, 20, 22-26 and 27, Yamazaki et al. disclose processed foods (i.e. bread, udon, soba, tempura, cakes, oil-fried quick breads) containing

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modified cereal flour wherein the cereal is wheat, barley, rye or oats (Abstract, C2/L32-33). Yamazaki et al. disclose that the cereal flour is modified by tempering cereal flour (i.e. pulverized seeds) in water at 0° to 60°C for 16 to 50 hours (C5/L22-34). Further, Yamazaki et al. disclose a bread made by kneading yeast, yeast food and water into the modified cereal flour, fermenting and aging the kneaded dough at 20° to 40°C for 20 minutes to 10 hours (C6/L33-38).

Given Yamazaki et al. disclose a food product including bread, udon and soba made by a process identical to that presently claimed, it is clear that the food product would inherently have an increased content of at least one free amino acid, GABA and/or dietary fiber.

In the alternative, regarding the method limitations recited in claims 1, 5-6 and 7, the examiner notes that even though a product-by-process is defined by the process steps by which the product is made, determination of patentability is based on the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As the court stated in *Thorpe*, 777 F.2d at 697, 227 USPQ at 966 (The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al. (US 6,106,887).

Regarding claim 19, Yamazaki et al. disclose all of the claim limitations as set forth above. Given Yamazaki et al. disclose barley grain broadly, since malt barley is a well known type of barley, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used any type of barley, including malt barley and arrive at the present invention.

Regarding claim 21, Yamazaki et al. disclose all of the claim limitations as set forth above. Yamazaki et al. disclose food products comprising 100% of modified cereal flour and does not disclose wherein the mix ratio of the added ingredient, i.e. modified cereal flour, to flour ranges from 10% to 50%. As flavor is a variable that can be modified, among others, by adjusting the amount added ingredient, i.e. modified cereal flour, in the flour-containing food product of Yamazaki et al., the precise amount of modified added ingredient would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed mixing ratio of added ingredient cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the amount of added ingredient in the flour-containing food product of Yamazaki et al. to obtain the desired flavor properties (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Response to Arguments

15. Applicant's arguments with respect to claims 1-4, 16 have been considered but are moot in view of the amendment filed 22 September 2009 and the new ground(s) of rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached on Monday - Friday; 7:30AM - 3:30PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./

Examiner, Art Unit 1794

/Keith D. Hendricks/

Supervisory Patent Examiner, Art Unit 1794